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MAILED

JUL 26 2010

OFFICE OF PETITIONS

In re Application of :
Wilhelm et al. : ON APPLICATION FOR
Application No. 09/876,915 : PATENT TERM ADJUSTMENT
Filed: June 8, 2001 :
For: SYSTEMS AND METHODS FOR :
ADAPTIVE SAMPLING AND :
ESTIMATING A SYSTEMATIC :
RELATIONSHIP BETWEEN A :
PLURALITY OF POINTS :
:

This is in response to the "PETITION REGARDING PATENT TERM ADJUSTMENT (PTA) INDICATED IN NOTICE OF ALLOWANCE" filed February 26, 2010. This request is properly treated under 37 CFR 1.705(b). Applicants request that the determination of patent term adjustment be corrected from two thousand two hundred twenty-six (2,226) days to two thousand eight hundred eighty-one (2,881) days.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of

issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

To the extent that applicant otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is GRANTED to the extent indicated herein.

On December 1, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 2226 days. The instant application for patent term adjustment was timely filed on February 26, 2010.

Applicants contends that a 276 day reduction for the submission of the petition to withdraw the holding of abandonment on January 14, 2009.

A review of the application history confirms an additional reduction for the failure to file a petition to withdraw the holding of abandonment within two months from the mailing of the Notice of Abandonment pursuant to 37 CFR § 1.704(c)(4) is required.

37 CFR 1.704(c) provides that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(4) Failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the mailing date of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed.

In this instance a Notice of Abandonment was mailed on February 13, 2008. A petition to withdraw the holding of abandonment was filed two months and 276 days after the Notice of Abandonment was mailed. The reduction is calculated beginning on the day after the date two months from after the mailing of the Notice

of Abandonment on April 14, 2008 and ending on the date a petition to withdraw the holding of abandonment was filed January 14, 2009.

Applicants' delay as of the mailing of the Notice of Allowance total is 306 (30 + 276) days.

Office delay as of the mailing of the Notice of Allowance total is 2226 (694 + 1562) days.

In view thereof, the correct determination of PTA at the time of the mailing of the notice of allowance is one thousand nine hundred fifty (**1,950**) days.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.



Anthony Knight

Director

Office of Petitions

Enclosure: Copy of REVISED PALM Screen

PALM INTRANET

PTA Calculations for Application: 09/876915

Application Filing Date:	06/08/2001	PTO Delay (PTO):	2256
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	30
Post-Issue Petitions:	0	Total PTA (days):	1950
PTO Delay Adjustment:	-276		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
63	07/23/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		276	
45	12/01/2009	MAIL NOTICE OF ALLOWANCE			
44	11/27/2009	ISSUE REVISION COMPLETED			
43	11/24/2009	EXAMINER'S AMENDMENT COMMUNICATION			
42	11/24/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
41	11/24/2009	DOCUMENT VERIFICATION			
40	11/24/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
39	11/23/2009	NOTICE OF ALLOWABILITY			
38	09/28/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
37	09/28/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	09/23/2009	DATE FORWARDED TO EXAMINER			
35	09/10/2009	RESPONSE AFTER NON-FINAL ACTION			
34	06/10/2009	MAIL NON-FINAL REJECTION	1562		13
33	06/08/2009	NON-FINAL REJECTION			
32	06/05/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
31	04/05/2009	DATE FORWARDED TO EXAMINER			
30	01/14/2009	RESPONSE AFTER NON-FINAL ACTION			
29	04/06/2009	MAIL NOTICE OF RESCINDED ABANDONMENT			
28	04/05/2009	NOTICE OF RESCINDED ABANDONMENT IN TCS			
27	02/06/2009	MAIL-PETITION DECISION - DISMISSED			
26	02/06/2009	PETITION DECISION - DISMISSED			

25	01/14/2009	PETITION ENTERED			
24	02/06/2009	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
23	02/06/2009	PETITION TO REVIVE APPLICATION - GRANTED			
22	01/14/2009	PETITION ENTERED			
21	02/13/2008	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
20	02/11/2008	ABAND. FOR FAILURE TO RESPOND TO O. A.			
19	07/02/2004	MAIL NON-FINAL REJECTION			
18	03/19/2007	NON-FINAL REJECTION			
17	03/21/2006	CASE DOCKETED TO EXAMINER IN GAU			
16	02/27/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
15	05/10/2005	CORRESPONDENCE ADDRESS CHANGE			
14	02/10/2005	DATE FORWARDED TO EXAMINER			
13	11/01/2004	RESPONSE AFTER NON-FINAL ACTION		30	9
12	11/01/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
10	11/01/2004	WORKFLOW INCOMING AMENDMENT IFW			
9	07/02/2004	MAIL NON-FINAL REJECTION	694		-1
8	06/27/2004	NON-FINAL REJECTION			
7	05/27/2004	CASE DOCKETED TO EXAMINER IN GAU			
6	08/30/2001	CASE DOCKETED TO EXAMINER IN GAU			
5	08/20/2001	TRANSFER INQUIRY			
4	08/08/2001	APPLICATION DISPATCHED FROM OIPE			
3	08/07/2001	CORRESPONDENCE ADDRESS CHANGE			
2	06/18/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	06/08/2001	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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